

REMARKS

I. Petition for Extension of Time

Applicants herewith petition the Commissioner for Patents to extend the time for response to the Office Action mailed 10 September 2009 for three (3) months from 10 December 2009 to 10 March 2010. Authorization is given to charge the extension of time fee of \$1110.00 (37 C.F.R. §1.136 and §1.17) to Deposit Account No. 23-1703. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.

II. Disposition of Claims

Claims 1, 2, 5-9 and 15-18 are pending. Claims 17-18 are withdrawn from consideration in view of the restriction requirement of record. Claims 1, 2, 5-9, 15 and 16 are rejected.

III. Claim Rejections – 35 U.S.C. §103

Claims 1, 2, 5-9, 15 and 16 are rejected under 35 U.S.C. §103(b) as being unpatentable over US 4,548,201 to Yoon (“Yoon”) in view of US 5,643,290 to Clark et al. (“Clark”).

On page 3 of the Office Action, the Examiner acknowledges that the primary reference to Yoon fails to disclose an expander device (**Fig. 21A**) having arms that are insertable between the fingers of the adaptor (**100, 101**). For this purpose, the Examiner relies on the secondary reference to Clark and states that Clark teaches that it is advantageous to insert arms of an expander device between fingers of an adaptor to provide better alignment and loading of a cord. In this regard, the Examiner cites Clark at column 2, lines 42-44, and the Abstract. In conclusion, the Examiner alleges that it would have obvious in view of Clark to have made the arms of the Yoon expander device (**Fig. 21A**) insertable between fingers of the adaptor **100, 101** in order to better align the adaptor and expander and to provide an even pushing force on the cord.

Applicants respectfully disagree and submit that the modification to Yoon as proposed by the Examiner would defeat the intended purpose and function of Yoon. Even after *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), it remains the law that the prior art cannot modified to meet the claimed invention if the modification would render the prior art unsatisfactory for its

intended purpose. In this regard, the Examiner's attention is directed to the guidance provided by lines provided by M.P.E.P §2143.01:

M.P.E.P §2143.01 "Suggestion or Motivation To Modify the References [R-6] - 2100 Patentability"

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART
UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

a. **Longitudinal channels 108**

On page 3 of the Office Action, the Examiner states that Yoon discloses channels **108** in the adaptor **100**, **101** for guiding a cord. By cord, Applicants assume that the Examiner means ring clip **10**. For the following reasons, Applicants submit that channels **108** are not designed or adapted to provide a guiding function as alleged by the Examiner.

Specifically, as disclosed by Yoon in column 10, ring clip **10** is made with a ring **12** of a material having sufficient elasticity. Embedded within ring **12** are clips **16** including needles **18**, serrated teeth **28**, pins **38**, etc. Figure 1 illustrates a ring clip **10** with needles **18** projecting into the lumen **14** of a ring clip **10**.

As illustrated in Figure 18, a ring loader **100** has one or more longitudinal channels **108**. Yoon discloses that channels **108** are dimensioned to accept files of clip teeth **18**, **28**, **38** (See col. 11, lines 10-26; Figs. 18 A and C). Alternatively, if the clip teeth **18**, **28**, **38** are designed to mesh or extend more than halfway across the lumen **14** of ring clip **10**, Yoon discloses that it would be preferable to use an accommodation channel **109** that completely bifurcates the elongated protrusion **104** of ring loader **100**. (See Fig. 18B). This alternative arrangement is designed to assure that the tips or teeth of ring clip **10** are not bent or dislocated during the loading operation (See col. 11, 15-26).

Thus, contrary to the Examiner's position, channels **108** (and **109**) are not designed or intended by Yoon to guide ring clip **10** along the length of ring loader **100** onto applicator **200**. As discussed in detail below, ring clip **10** is guided along the length of ring loader **100** by the cooperation of the ring clip **10** and ring dilator. Rather, channels **108** and **109** are designed for

the express purpose of protecting fragile clip teeth **18, 28, 38** from damage. Accordingly, to achieve this protective function, channels **108** and **109** should be free of any other structural element that could bend, dislocate or otherwise interfere with the passage of clip teeth **18, 28, 38** through channels **108, 109** during the loading operation. Therefore, the Examiner's proposed modification of the arms of ring dilator (**Fig. 21A**) to have projections insertable in channels **108, 109** would defeat the intended purpose and function of Yoon.

Moreover, modifying the arms of ring dilator (**Fig. 21A**) to have projections similar to clip teeth **18, 28, 38** - as suggested by the Examiner - would result in thin, fragile arms incapable of serving any guiding function. Such thin arms would easily fail upon the application of force to push the ring clip **10** onto the increasing cross-sectional surface of the ring loader **100**. Furthermore, narrowing the inner diameter of the arms of the ring dilator (**Fig. 21A**) to match channels **108** and **109** - as suggested by the Examiner - could possibly weaken the structural integrity of the ring dilator thus rendering it unsuitable for its purpose, i.e., resting against and ideally covering the base of ring clip **10** to distribute pressure over the surface of the ring clip **10**. (See col. 11, lines 32-37).

In summary, therefore, channels **108** and **109** are expressly designed to protect the fragile clip teeth **18, 28, 38** from damage. It would defeat Yoon's intended purpose and function if the arms of the ring dilator (**Fig. 21A**) were modified to have projections insertable in channels **108** which could cause damage to or otherwise interfere with the passage of clip teeth **18, 28, 38** in channels **108** and **109**. In any event, the Examiner's proposals for modifying the arms of the ring dilator to have projections insertable in channels **108** are structurally impractical.

b. Ring dilator 130, 131, Fig. 21A

Yoon discloses the following three embodiments of a ring dilator:

1. Figure 18 – ring dilator **130**;
2. Figure 20 – ring dilator **131** and
3. Figure 21A.

Ring dilators **130** and **131** are described at column 11, lines 27-58 and lines 29-36, respectively. However, the Examiner relies on the ring dilator of Figure 21A for which there is

no written description other than: “FIGS. 21A and 21 B show ring dilators that are suitable for pushing a ring clip unto the intermediate cylinder B of an applicator via a ring loader **100**, **101**.”

Notwithstanding the absence of any written description, Applicants submit that the ring dilator of Figure 21A must share the same essential features of the ring dilators **130** and **131**. Specifically, each of ring dilators **130** and **131** is deformable allowing a central aperture **134** to adapt to the increasing cross-sectional area of the conic surfaces **102**, **103** of ring loaders **100**, **101** (See Figs. 18 and 19). Expansion of the central aperture **134** is necessary so that the sides of aperture **134** continue to press against and ideally cover the base **13** of ring clip **10** to uniformly distribute pressure against the surface of base **13** as both the ring clip **10** and ring dilator **130**, **131** pass over the increasing cross-sectional diameter of the ring loader. Thus, Yoon provides for alignment of the ring loader **100**, **101** and ring dilator **130**, **131**, **FIG. 21A** and an even pushing force by the intimate and constant contact between the central aperture **134** and the base **13** of ring clip **10**.

However, the central aperture of the ring dilator of Figure 21A does not expand in the same way as the central aperture **134** of the ring dilator **130**, **131**. Rather, it is evident from Figure 21A that the arms of the ring dilator of Figure 21A spread or fan out with pressure to create a wider central aperture to accommodate passage over the increasing cross-sectional diameter of the ring loader **100**, **101**. As required by Yoon, the central aperture maintains a consistent and expanding contact with the base **13** of ring clip **10** to provide alignment and an even pushing force.

Applicants submit that there is no need or motivation to adapt the arms of the ring dilator (**Fig. 21A**) to channels **108/109**. Yoon achieves a satisfactory alignment and constant pushing force by the cooperation of the ring clip **10** and central aperture of the ring dilator as both expand and adapt to the increased cross-sectional diameter of the ring loader **100**, **101**.

Finally, it is noted that the arms of ring dilators **130** and **131** cannot be provided with projections to match the channels **108** or **109**. Therefore, since the ring dilator of Figure 21A must share the same essential features as ring dilators **130**, **131**, so too must the arms of the ring dilator of Figure 21A be free of any projections that could bend, dislocate or otherwise interfere with the passage of clip teeth **18**, **28**, **38** through channels **108** or **109**.

For all of the foregoing reasons, Applicants submit that a *prima facie* case of obviousness has not been established. The structural modifications proposed the Examiner to meet the claimed invention are either (a) unnecessary since Yoon already provides a system that ensures alignment and an even pushing force or (2) would render Yoon unsatisfactory for its intended purpose. As such, the obviousness rejection based on the combination of Yoon and Clark is improper. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). Withdrawal of the §103 rejection is requested.

CONCLUSION

Applicants have made a good faith attempt to respond to the Office Action. It is respectfully submitted that claims 1, 2, 5-9, 15 and 16 are in condition for allowance, which action is earnestly solicited.

Any fees due in connection with this response should be charged to Deposit Account No. 23-1703.

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Respectfully submitted,

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